

## UNITED STATES PATENT AND TRADEMARK OFFICE

1FW 2131

In re Patent Application of

Atty Dkt. 550-212

C# M#

TARBOTTON et al

TC/A.U.

2131

Serial No. 09/785,222

Examiner: L. Chai

Filed: February 20, 2001

Date: January 19, 2005

Title: SOFTWARE AUDIT SYSTEM

**Mail Stop Non-Fee Amendment**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

**RESPONSE/AMENDMENT/LETTER**

This is a response/amendment/letter in the above-identified application and includes an attachment which is hereby incorporated by reference and the signature below serves as the signature to the attachment in the absence of any other signature thereon.

☒ **Correspondence Address Indication Form Attached.****Fees are attached as calculated below:**

Total effective claims after amendment **54** minus highest number  
previously paid for **54** (at least 20) = 0 x \$50.00 \$0.00 (1202)/\$0.00 (2202) \$

Independent claims after amendment **3** minus highest number  
previously paid for **3** (at least 3) = 0 x \$200.00 \$0.00 (1201)/\$0.00 (2201) \$

If proper multiple dependent claims now added for first time, (ignore improper); add  
\$360.00 (1051)/\$180.00 (2051) \$

Petition is hereby made to extend the current due date so as to cover the filing date of this  
paper and attachment(s)  
One Month Extension \$120.00 (1251)/\$60.00 (2251)  
Two Month Extensions \$450.00 (1252)/\$225.00 (2252)  
Three Month Extensions \$1020.00 (1253)/\$510.00 (2253)  
Four Month Extensions \$1590.00 (1254)/\$795.00 (2254) \$

Terminal disclaimer enclosed, add \$130.00 (1814)/\$65.00 (2814) \$

☐ Applicant claims "small entity" status. ☐ Statement filed herewith

Rule 56 Information Disclosure Statement Filing Fee \$180.00 (1806) \$

Assignment Recording Fee \$40.00 (8021) \$

Other: \$

**TOTAL FEE ENCLOSED \$ 0.00**

The Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, in the fee(s) filed, or asserted to be filed, or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Account No. 14-1140. A duplicate copy of this sheet is attached.

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NIXON & VANDERHYE P.C.  
By Atty: Stanley C. Spooner, Reg. No. 27,893

Signature: 



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of

TARBOTTON et al

Atty. Ref.: 550-212; Confirmation No. 3948

Appl. No. 09/785,222

TC/A.U. 2131

Filed: February 20, 2001

Examiner: L. Chai

For: SOFTWARE AUDIT SYSTEM

\* \* \* \* \*

January 19, 2005

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**REQUEST FOR RECONSIDERATION**

This is a Request for Reconsideration of the Official Action mailed October 19, 2004 (Paper No. 4), the date of response to which is January 19, 2005.

In the outstanding Official Action, claims 1-54 have been rejected. Claims 1-54 are not amended and remain in this application.

The Examiner's indication of acceptance of the formal drawings filed May 3, 2001 is very much appreciated.

Claims 1, 15, 16, 19, 33, 34, 37, 51 and 52 stand rejected under 35 USC §102(e) as being anticipated by Kouznetsov (U.S. Patent 6,029,256). Applicants' independent claims 1, 19 and 37 all require either the method step or apparatus for accomplishing the method step of generating "audit data identifying said computer program." The desire is to be able to have software auditing accomplished without the disadvantages of the software for accomplishing the software

audit representing an additional computer program that must be installed and maintained on the computer system, as well as consuming potentially significant processing resources of the computer system (see the discussion in Applicants' description of the prior art as to the need in the industry (specification page 1, lines 5-20)).

Applicants' claimed invention accomplishes this benefit by providing audit data based upon computer virus scanner logic, thereby piggybacking the desired audit data on the back of an anti-virus computer program. This benefit is discussed in Applicants' specification, page 2, lines 9-26. The beneficial invention is further specified by each of Applicants' independent claims 1, 19 and 37 requiring, in response to the computer virus scanning logic identifying computer files to be scanned, the generation of audit data identifying the computer program. Thus, Applicants' invention is a computer program product (claim 1), a method (claim 19) and an apparatus (claim 37) which accomplishes this beneficial result in the claimed manner.

Kouznetsov contains no recognition of the problem solved by the presently claimed invention, i.e., generating the desirable audit data without the undesirable aspects comprising an additional computer program and/or consuming significant processing resources of the computer system. The Examiner has failed to point out how or where Kouznetsov contains any recognition of the problem solved by Applicants' invention.

Moreover, Kouznetsov does not "generate audit data identifying said computer program" as alleged by the Examiner on page 3, lines 6 and 7 of the Official Action. The Examiner refers to Kouznetsov at column 5, lines 50-60 (the Official Action at line 7 of page 3 was blurred, but Applicants presume that the citation to Kouznetsov is the same as the previous citation in line 1) as support for the Examiner's conclusion. However, the cited portion of the Kouznetsov reference clearly specifies that the "result property 120 indicates whether a method call

succeeded or failed. This property is of an integer data type and is only meaningful after a scan has been invoked.” (Column 5, lines 50-52, emphasis added). Kouznetsov clearly teaches that what is generated is an integer indicating whether a method call succeeded or failed.

There is no mention of any audit data identifying a computer program or a computer program for which a request for execution has been made in Kouznetsov. Should the Examiner believe the disclosure of the “file property 112” contained in column 5, lines 15-25 to be of interest, file property 112 is an item of information which is supplied to the virus scanner, rather than one which is generated by the virus scanner.

Again, it may be helpful to read Applicants’ independent claims which recite the computer virus scanner logic which identifies a computer file to be scanned for computer viruses and the audit data generator logic which is responsive to the computer virus scanner logic and the data identifying the computer file to be scanned and identifies a request to execute a computer program and in response to this identification generates audit data identifying the computer program.

There is no recognition or suggestion by the Examiner that any portion of the Kouznetsov reference contains any disclosure of the “generate audit data identifying said computer program” requirement of Applicants’ independent claims 1, 19 and 37.

Accordingly, and in view of the above, Kouznetsov not only fails to anticipate independent claims 1, 19 and 37, it clearly fails to anticipate any claims dependent thereon, including claims 15, 16, 33, 34, 51 and 52.

Claims 2-5, 20-23 and 38-41 stand rejected under 35 USC §103 as unpatentable over Kouznetsov in view of Shiakallis (U.S. Patent 6,009,518). Inasmuch as claims 2-5, 20-23 and 38-41 all depend upon independent claims 1, 19 and 37, respectively, the above comments

distinguishing independent claims 1, 19 and 37 over the Kouznetsov reference are herein incorporated by reference. Furthermore, the Examiner's attention is directed towards 35 USC §103(c) which states that subject matter which qualifies as prior art only under subsection (e) of §102 "shall not preclude patentability under this section where the subject matter in the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person."

Applicants note that Network Associates Inc. is the assignee of the Kouznetsov reference, which was the predecessor in interest to Networks Associates Technology, Inc. the current application's assignee. Accordingly, pursuant to 35 USC §103(c), Kouznetsov is not available as a reference against claims 4, 11 and 18 under 35 USC §103.

While the Examiner's admission that "Kouznetsov does not teach a file access request to an operating system triggers generation of said computer virus scan request" is appreciated, the Examiner has not alleged that Shiakallis teaches any structure for generating "audit data identifying said computer program." Inasmuch as this structure or method step is not disclosed in either Kouznetsov or Shiakallis, there is no support for any rejection of claims 2-5, 20-23 and 38-41 under 35 USC §103.

Even if Applicants' claimed structure and method steps were somehow disclosed in the Shiakallis reference, the Examiner has provided no motivation or rationale for combining the Kouznetsov and Shiakallis references. In fact, the Examiner has not identified where either reference bears any relationship to the problem solved by Applicants' invention and thus there is no support for the argument that it would be obvious to combine the teachings of the two references. Thus, the Patent Office has simply failed to provide the necessary support for a

*prima facie* case of obviousness of claims 2-5, 20-23 and 38-41 under 35 USC §103 over the Kouznetsove/Shiakalli combination.

Claims 11-14, 17, 18, 29-32, 35, 36, 47-50, 53 and 54 stand rejected under 35 USC §103 as unpatentable over Kouznetsov in view of Hypponen (U.S. Patent 6,577,920). Inasmuch as claims 11-14, 17, 18, 29-32, 35, 36, 47-50, 53 and 54 all depend from independent claims 1, 19 and 37, the above comments regarding these independent claims distinguishing over the Kouznetsov reference are herein incorporated by reference. Additionally, as noted above, Kouznetsov is not available as prior art in an obviousness rejection pursuant to 35 USC §103(c). Moreover, the Examiner's admission that "Kouznetsov does not teach audit data generator logic calculates a checksum value from said computer file, said checksum value being used in identification of said computer file as a particular program" is very much appreciated.

Again, the Examiner fails to allege that Hypponen teaches the generation of audit data identifying said computer program as required by Applicants' independent claims 1, 19 and 37. Additionally, the Examiner has not alleged that Hypponen contains any recognition of the problem solved by Applicants' claimed invention, which recognition is also missing from Kouznetsov. Finally, the Examiner has failed to meet the burden of establishing a *prima facie* case of obviousness by pointing out some motivation or rationale for combining teachings taken from the Kouznetsov and Hypponen references. Accordingly, any further rejection of claims 11-14, 17, 18, 29-32, 35, 36, 47-50, 53 and 54 is respectfully traversed.

Claims 6-10, 24-28 and 42-46 stand rejected under 35 USC §103 as unpatentable over Kouznetsov in view of Shiakallis and in view of Christiano (U.S. Patent 5,671,412). Inasmuch as claims 6-10, 24-28 and 42-46 depend from claims 1, 19 and 37, respectively, the above comments distinguishing the independent claims from the Kouznetsov and Shiakallis references

are herein incorporated by reference. Additionally, as noted above, Kouznetsov is not available as prior art in an obviousness rejection pursuant to 35 USC §103(c).

The Examiner's admits that "Kouznetsov does not teach the record of system usage to identify a request to execute a computer program." It is also noted that the Examiner has not suggested that Christiano teaches the missing aspect from Applicants' independent claims, i.e., a program product, method or apparatus for generating "audit data identifying said computer program." Moreover, the Examiner has not alleged that Christiano recognizes the problem solved by Applicants' claimed invention, such recognition not present in either Kouznetsov or Shiakallis.

Finally, the Examiner has failed to provide any indication that any of the three cited references, Kouznetsov, Shiakallis or Christiano, contains any motivation or rationale for combining the references in the manner of Applicants' independent claims, let alone in the manner of Applicants' dependent claims. Accordingly, any further rejection of claims 6-10, 24-28 and 42-46 as being obvious over the Kouznetsov/Shiakallis/Christiano combination is respectfully traversed.

The Court of Appeals for the Federal Circuit has held in the case of *In re Rouffet*, 47 USPQ2d 1453, 1457-8 (Fed. Cir. 1998) that

"[t]o prevent the use of hindsight based on the invention to defeat patentability of the invention, this court **requires** the examiner to **show a motivation to combine** the references that create the case of obviousness. In other words, **the Examiner must show reasons** that the skilled artisan, confronted with **the same problems** as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." (emphasis added).

The Court of Appeals for the Federal Circuit has consistently held, as noted above, that the burden is on the Examiner to show a "motivation" to combine references and "reasons that

the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.”

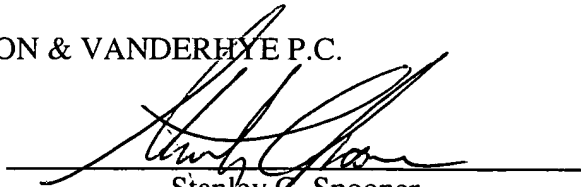
The Examiner has simply failed in each of the above discussed rejections to show any motivation to combine the references and has failed to show that any of the prior art references are even aware of the problems solved by the present invention. In order to sustain the Patent Office burden of proof to establish a *prima facie* case of obviousness, the Examiner must provide the missing information. If the Examiner is unable to provide this information, he or she should admit that there is simply no support for the rejection as set out in the outstanding Official Action. As a result, reconsideration of all of the rejections is respectfully requested.

Having responded to all objections and rejections set forth in the outstanding Official Action, it is submitted that claims 1-54 are in condition for allowance and notice to that effect is respectfully requested. In the event the Examiner is of the opinion that a brief telephone or personal interview will facilitate allowance of one or more of the above claims, he is respectfully requested to contact Applicants' undersigned representative.

Respectfully submitted,

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